PTO Form 1930 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 05/31/2014)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	78572707
LAW OFFICE ASSIGNED	LAW OFFICE 115
MARK SECTION (no change)	
ARGUMENT(S)	

REQUEST FOR RECONSIDERATION

The Examining Attorney has refused registration of the subject application pursuant to Section 2(d) of the Trademark Act. The Applicant respectfully disagrees and wishes to request the Examining Attorney's reconsideration of the refusal due to the following new issues. Subsequent to the issuance of the outstanding Office Action, another pending application for registration of a mark wholly incorporating the terms "PLAN B" for use with a wide variety of general apparel goods reached publication. More specifically, U.S. Application Serial No. 85/636,433 for the mark THERE'S NO PLAN B owned by All In Beverages, LLC ("AIB") of Orlando, Florida. It is clear AIB is unrelated to the cited registrant. A copy of the AIB application information is attached for the Examining Attorney's convenience. We also note the identification of goods in the AIB application are:

> *"Footwear, wrist bands, gloves, hooded sweat shirts, sweat shirts, headwear, socks, T-shirts, sweat pants, shorts, swim suits, sports bras, underwear, jackets, coats," in International Class 25*

Applicant contends that the subject application for registration of the mark PLAN B SKATEBOARDS with technical skateboard equipment including apparel and footwear for use while skateboarding should also be able to coexist on the Trademark Register just as it has been coexisting in the marketplace for two decades. Moreover, the technical skateboard products identified in the subject application are far less similar than the goods in the AIB application as compared to the goods in the cited registration.

Similarly to the mark in the AIB application, the subject mark includes the terms "PLAN B" with additional term(s). The additional term(s) distinguishes the Applicant's mark from the cited mark as well as AIB's mark. It should be noted that the Applicant's application was filed several years prior to the AIB application. In any case, the Applicant maintains its opinion that the cited mark, AIB's mark and the Applicant's mark are all distinguishable in sound, appearance, meaning and overall commercial impression so as to substantially minimize the possibility of consumer confusion. However, in the Applicant's case, the distinct differences between the goods used with the Applicant's mark and the goods as identified in the cited registration and the published AIB application are so substantial and clearly different, the possibility of consumer confusion is non-existent. In order to further highlight this fact, Applicant further amends the identification of goods in the subject application to reflect the following:

> *"Technical skateboard clothing, namely, shirts, pants, footwear and headgear" in International Class 25*

As discussed above, the Applicant has been using the mark PLAN B SKATEBOARDS and formatives thereof for two decades with a variety of skateboard specific products and services and owns numerous United States and international registrations for such marks including a recently published application for registration of the mark PLAN B and Design in a stylized form for use with a wide variety of retail services (U.S. Serial No. 85/469,962).

Applicant submits the strength of the mark sought to be protected is an important consideration in the likelihood of confusion analysis. It is well settled that "weaker" marks are not entitled to the wide latitude of protection afforded the owner of "strong" trademarks. McCarthy on Trademarks, Section 11:73; King Candy Co. v. Eunice King's Kitchen, Inc. , 496 F.2d 1400, 182 U.S.P.Q. 108 (C.C.P.A. 1974). In the present case, it is respectfully submitted that the refusal to register the subject application provides broader protection to the cited Registrant than it is entitled to under the parameters of Section 2(d) of the Trademark Act. This contention is clearly submitted by the existence of the recently published AIB application. The Registrant does not own an exclusive right to use the terms PLAN B much less PLAN B SKATEBOARDS or THERE'S NO PLAN B which present distinctly different commercial impressions.

Whether a mark is classified as strong or weak is a very important element in deciding likelihood of confusion. See, McCarthy on Trademarks (4th Ed.) Section 23:48. "Where a party uses a weak mark, his competitors may come closer to his mark than would be the case without violating his rights." Kenner Parker Toys, Inc. v. Rose Art Indus., Inc., 22 USPQ2d 1453 (Fed. Cir. 1992). When selecting a mark which is a common name, or commonly used in the field, the owner assumes some degree of risk of uncertainty that competitors may come closer to his mark by adopting marks with the same or similar characteristics. Milwaukee Nut Co. v. Brewster Food Service, 125 USPQ 399 (CCPA 1960).

Where the common portion of the marks at issue are weak, even minor differences in the remaining portion of the marks could make for marks which overall, are not confusingly similar because "consumers distinguish between these usages." In re National Data Corp., 224 USPQ 749 (Fed. Cir. 1985); Glamorene Prods. v. Earl Grissmer, 203 USPQ 1090 (TTAB 1979)(No confusion found between SPRAY' N VAC v. RISENVAC, both for vacuum rug cleaners); Mead Johnson & Co. v. Peter Eckes, 195 USPQ 187 (TTAB 1977) (No confusion found between METRECAL for dietary products and MINICAL for dietary food products); Basic Vegetable Prods. Inc. v General Foods Corp., 165 USPQ 781 (TTAB 1970) (MAGIC v SOUR MAGIC) (The Board noted that frequent adoption and registration of the term MAGIC is sufficient to distinguish MAGIC and SOUR MAGIC. "The theory behind this rests on the obvious character of the term . . . purchasers have been exposed in a particular trade to such a plethora of trade designations containing this notation that they have become accustomed to distinguishing between them.") In the present case, the non-common portion or order of the terms in the respective marks creates marks with different sound, appearance, meaning and overall commercial impression such that consumers would not find the marks confusingly similar.

In making the determination as to whether there is a likelihood of confusion or not, important factors to be considered are the similarity or dissimilarity of the respective marks as to appearance, sound, commercial impression and connotation. Giant Food, Inc. v. Nation's Foodservice, Inc. , 710 F2d 1565, 218 USPQ 390 (Fed. Cir. 1983). Moreover, trademarks should be considered in their entireties, the way consumers encounter them. Their individual components should not be dissected and analyzed piecemeal. In re Bed & Breakfast Registry, 229 USPQ 818 (Fed. Cir. 1986). The commercial impression of a trademark is derived from it as a whole, not from elements separated and considered in detail. Estate of P.D. Beckwith Inc. v. Commissioner of Patents, 252 US 528 (1920).

Applicant submits that the mark PLAN B SKATEBOARDS conveys a distinguishable commercial impression to the cited mark PLAN B JEANS and even THERE'S NO PLAN B such that consumers would not be confused by the contemporaneous use of the respective marks as to source, affiliation or sponsorship. Clearly, the mere incorporation of terms within one mark which exist also in a registered mark does not, *ipso facto*, create a likelihood of confusion between the marks. See, Electronic Data System Corp. v. EDSA Micro Corp., 23 USPQ2d 1460, (TTAB 1992) at page 1463 (finding confusion not likely between EDSA for computer programs for electrical distribution system analyses and design and EDS for computer data processing programming services).

The Applicant respectfully submits that the marks are visually dissimilar. The similarity of appearance of marks has been described as nothing more than a subjective "eyeball" test. General Foods Corp. v. Ito Yokado Co., 219 USPQ 822 (TTAB 1983), McCarthy on Trademarks and Unfair Competition, Section 23:25, 4th Ed. Here, the mere fact that the respective marks share some common terms is not dispositive of confusion. The Second Circuit addressed this issue in Lang v. Retirement Living Publishing, 21 USPQ 1041, 1045 (2nd Cir. 1991) wherein the court found no similarity of appearance between NEW CHOICES PRESS for publishing services and NEW CHOICES FOR THE BEST YEARS for magazines.

Here, the mark PLAN B SKATEBOARDS is visually distinctive of the cited mark PLAN B JEANS and even the published AIB mark THERE'S NO PLAN B. Given the fact that the Applicant's mark conveys a unique commercial impression due to the incorporation of the term SKATEBOARDS distinguishes the marks just like AIB's mark was distinguishable from the cited mark and apparently the Applicant's mark as it was filed several years prior to the AIB application. All of which leads to the inescapable conclusion that the marks are visually distinctive of one another and convey distinctly different meanings.

Moreover, the Applicant respectfully submits that the non-common portion of the respective marks not only renders the marks distinguishable to the ear and to the eye, but the differences in the marks also serve to give the marks different meanings and overall commercial impressions. As noted by the Tenth Circuit Court of Appeals, "it is not necessary for similarity to go only to the eye or the ear for there to be

infringement. The use of a designation which causes confusion because it conveys the same idea, or stimulates the same mental reaction, or has the same meaning." If two conflicting marks each have an aura of suggestion, but each suggests something different to the buyer, this tends to indicate a lack of likelihood of confusion. See, McCarthy on Trademarks and Unfair Competition (4th Ed.), Section 23:28. Similarly, marks may be phonetically similar (not the case here), but confusion is prevented by different suggestive connotations of the marks. See, Republic Steel Corp. v MPH Mfg. Corp., 136 USPQ 447 (CCPA 1963) (Different connotation of TRUSS-SKIN v. TRUSCON for metal building parts); Morrison Milling Co. v. General Mills, Inc., 168 USPQ 591 (CCPA 1971) (different connotations of CORN-KITS and CORN KIX); General Mills , Inc. v. Frito Lay, Inc., 176 USPQ 148 (TTAB 1972) (no likely confusion between FUNYUMS and ONYUMS; different suggestive connotation).

Here, the Applicant submits that the overall suggestion, image and commercial impression conveyed by the Applicant's mark is distinguishable from the cited mark so as to obviate consumer confusion. See, Champagne Louis Roederer S.A. v. Delicato Vineyards, 148 F.3d 1373 (Fed. Cir. 1998) (CRISTAL for champagne and CRYSTAL CREEK for wines held not confusingly similar. The marks "evoked very different images in the minds of relevant consumers": while CRISTAL suggests the clarity of the wine in the bottle or the glass, CRYSTAL CREEK suggests a clear, remote stream.); Hard Rock Cafe Licensing Corp. v. Elsea, 48 USPQ2d 1400 (TTAB 1998) (COUNTRY ROCK CAFE v. HARD ROCK CAFE for restaurant services not held confusingly similar. "[W]e believe there is no question that "country rock" and "hard rock" evoke quite different images for consumers.") It is respectfully submitted that the cited mark conjures up different images in the mind of the consumer.

Applicant relies on the following cases in support of the proposition that there is no rule that confusion is automatically likely if the junior user has a mark that contains in part the whole of another's mark. See Colgate Palmolive Co. v. Carter-Wallace, Inc., 167 USPQ 529 (CCPA 1970) (PEAK PERIOD for deodorant not confusingly similar to PEAK for denitrifies); Lever Bros. Co. v. Barcolene Co., 174 USPQ 392 (CCPA 1972) (ALL CLEAR for household cleaners not confusingly similar to ALL for household cleaners); In re Ferrero 178 USPQ 167 (CCPA 1973) (TIC TAC for candy not confusingly similar to TIC TAC TOE for ice cream). Accordingly, the Applicant respectfully submits that its mark

conveys a distinguishable commercial impression separate and apart from the Registrant's mark such that consumers would not find the respective marks confusingly similar.

As the Examining Attorney is well aware, the standard under Section 2(d) is likelihood of confusion, not mere possibility of confusion. As noted by the Trademark Trial and Appeal Board in determining likelihood of confusion, "we are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal." Witco Chemical Co., Inc. v. Whitfield Chemical Co., Inc. 418 F.2d 1403, 164 USPQ 43, 44-45 (CCPA 1969).

In addition to the differences in the marks, there are also significant differences between the goods (especially as further amended herein) with which the marks are used, such that no likelihood of confusion exists. In order for there to be confusion as to source, connection, or sponsorship of the goods of the Applicant and the goods of the cited Registrant, the goods would have to be of such a nature that they would come to the attention of the same kinds of purchasers. In re Shipp, 4 USPQ2d 1174, 1176 (TTAB 1987); In re Fresco Inc., 219 USPQ 437, 438 (TTAB 1983). It has long been held that even where the marks are identical in every respect (here they are not), confusion would not be likely if the goods are not related, or if the goods are not marketed in such a way that would create the incorrect assumption that they originate from the same source. See, e.g., Local Trademarks, Inc. v. Handy Boys Inc., 16 USPQ 1156 (TTAB 1990). The prime limitation is that trademark rights extend only as far as necessary to avoid consumer confusion. WCVB-TV v Boston Athletic Ass'n., 17 USPQ2d 1688, 1690 (1st Cir. 1991) ("The trademark statute does not give [any] property right in the mark except the right to prevent confusion.") There is no monopoly, or "right in gross" in a mark. University of Notre Dame v J.C. Gourmet Food Imports Co., 217 USPQ 505, 507 (Fed. Cir. 1983)(A right in gross is contrary to the principle of trademark law.)

Further, past decisions of the federal courts and the Trademark Trial and Appeal Board (hereinafter the "TTAB") applying "per se" rules that goods and services in the same general field and bearing the same mark are so similar or related that confusion as to origin is likely have been criticized as being too inflexible. Such decisions are seen as being contrary to a basic tenet of trademark law, namely that each likelihood of confusion case must be decided based on its own facts and circumstances. See, Interstate

Brands v. Celestial Seasonings, 576 F.2d 926, 928 (CCPA. 1978) (no "per se" rule for foods); In re The Shoe Works, Inc., 6 USPQ2d 1890, 1891 (TTAB 1988) (no "per se" rule that the use of the same mark on different items of wearing apparel likely to cause confusion.)

It is respectfully submitted that Applicant's goods and Registrant's goods are not marketed in such a way that would create the incorrect assumption that they originate from the same source. The Applicant respectfully submits that notwithstanding the fact that the respective goods may be broadly generalized as related to the apparel field, this fact does not render them sufficiently related to support the Examining Attorney's refusal when the use and registration of marks incorporating the terms PLAN B is factored into the equation.

It is respectfully submitted that the Applicant's goods must be suited to the each individual consumer who is discriminating and extends great care in deciding the source of an item. The Applicant's products would not be purchased on impulse, but only after deliberate, careful consideration, knowing exactly with whom the consumer is dealing. Given the differences between the Registrant's mark and the Applicant's mark, and the significant differences between Registrant's goods and the Applicant's goods, Applicant respectfully submits that a likelihood of confusion as defined by Trademark Act Section 2(d) does not exist. The Applicant therefore respectfully requests that the Section 2(d) refusal should be withdrawn.

EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_6520036157-180559058_._THERES_NO_PLAN_B_-_AIB_Application.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT16\IMAGEOUT16\785\727\78572707\xml4\RFR0002.JPG
DESCRIPTION OF EVIDENCE FILE	AIB Application
GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	025
DESCRIPTION	

Skateboard clothing, namely, shirts, pants, footwear, headwear, sweatshirts and gloves	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	025
TRACKED TEXT DESCRIPTION	
~~Skateboard clothing, namely, shirts, pants, footwear, headwear, sweatshirts and gloves~~; Technical skateboard clothing, namely, shirts, pants, footwear and headgear	
FINAL DESCRIPTION	
Technical skateboard clothing, namely, shirts, pants, footwear and headgear	
FILING BASIS	Section 1(b)
SIGNATURE SECTION	
RESPONSE SIGNATURE	/dax alvarez/
SIGNATORY'S NAME	Dax Alvarez
SIGNATORY'S POSITION	Attorney of Record, CA Bar Member
SIGNATORY'S PHONE NUMBER	3102073800
DATE SIGNED	06/07/2013
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Fri Jun 07 18:19:03 EDT 2013
TEAS STAMP	USPTO/RFR-65.200.36.157-20130607181903697168-78572707-500e7d1e7f4ebd3131e74747e2d4a7676a0a0ed83905ddb74561fdff51741a0de-N/A-N/A-20130607180559058641

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **78572707** has been amended as follows:

ARGUMENT(S)
In response to the substantive refusal(s), please note the following:

REQUEST FOR RECONSIDERATION

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likely between EDSA for computer programs for electrical distribution system analyses and design and EDS for computer data processing programming services).

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confusion between FUNYUMS and ONYUMS; different suggestive connotation).

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As the Examining Attorney is well aware, the standard under Section 2(d) is likelihood of confusion, not mere possibility of confusion. As noted by the Trademark Trial and Appeal Board in determining likelihood of confusion, “we are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal.” Witco Chemical Co., Inc. v. Whitfield Chemical Co., Inc. 418 F.2d 1403, 164 USPQ 43, 44-45 (CCPA 1969).

In addition to the differences in the marks, there are also significant differences between the goods

(especially as further amended herein) with which the marks are used, such that no likelihood of confusion exists. In order for there to be confusion as to source, connection, or sponsorship of the goods of the Applicant and the goods of the cited Registrant, the goods would have to be of such a nature that they would come to the attention of the same kinds of purchasers. In re Shipp, 4 USPQ2d 1174, 1176 (TTAB 1987); In re Fresco Inc., 219 USPQ 437, 438 (TTAB 1983). It has long been held that even where the marks are identical in every respect (here they are not), confusion would not be likely if the goods are not related, or if the goods are not marketed in such a way that would create the incorrect assumption that they originate from the same source. See, e.g., Local Trademarks, Inc. v. Handy Boys Inc., 16 USPQ 1156 (TTAB 1990). The prime limitation is that trademark rights extend only as far as necessary to avoid consumer confusion. WCVB-TV v Boston Athletic Ass'n., 17 USPQ2d 1688, 1690 (1st Cir. 1991) ("The trademark statute does not give [any] property right in the mark except the right to prevent confusion.") There is no monopoly, or "right in gross" in a mark. University of Notre Dame v J.C. Gourmet Food Imports Co., 217 USPQ 505, 507 (Fed. Cir. 1983)(A right in gross is contrary to the principle of trademark law.)

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It is respectfully submitted that the Applicant's goods must be suited to the each individual consumer who is discriminating and extends great care in deciding the source of an item. The Applicant's products would not be purchased on impulse, but only after deliberate, careful consideration, knowing exactly with whom the consumer is dealing. Given the differences between the Registrant's mark and the Applicant's mark, and the significant differences between Registrant's goods and the Applicant's goods, Applicant respectfully submits that a likelihood of confusion as defined by Trademark Act Section 2(d) does not exist. The Applicant therefore respectfully requests that the Section 2(d) refusal should be withdrawn.

EVIDENCE
Evidence in the nature of AIB Application has been attached.
Original PDF file:
evi_6520036157-180559058_._THERES_NO_PLAN_B_-_AIB_Application.pdf
Converted PDF file(s) (1 page)
Evidence-1

CLASSIFICATION AND LISTING OF GOODS/SERVICES
Applicant proposes to amend the following class of goods/services in the application:
Current: Class 025 for Skateboard clothing, namely, shirts, pants, footwear, headwear, sweatshirts and gloves
Original Filing Basis:
Filing Basis: Section 1(b), Intent to Use: The applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Proposed:
Tracked Text Description: ~~Skateboard clothing, namely, shirts, pants, footwear, headwear, sweatshirts and gloves~~; Technical skateboard clothing, namely, shirts, pants, footwear and headgear

Class 025 for Technical skateboard clothing, namely, shirts, pants, footwear and headgear
Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

SIGNATURE(S)
Request for Reconsideration Signature
Signature: /dax alvarez/ Date: 06/07/2013
Signatory's Name: Dax Alvarez
Signatory's Position: Attorney of Record, CA Bar Member

Signatory's Phone Number: 3102073800

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the

highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 78572707
Internet Transmission Date: Fri Jun 07 18:19:03 EDT 2013
TEAS Stamp: USPTO/RFR-65.200.36.157-2013060718190369
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TESS was last updated on Fri Jun 7 02:10:10 EDT 2013

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Record 1 out of 1

There's No Plan B

Word Mark	THERE'S NO PLAN B
Goods and Services	IC 025. US 022 039. G & S: Footwear, wrist bands, gloves, hooded sweat shirts, sweat shirts, headwear, socks, T-shirts, sweat pants, shorts, swim suits, sports bras, underwear, jackets, coats
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	85636433
Filing Date	May 27, 2012
Current Basis	1B
Original Filing Basis	1B
Published for Opposition	May 14, 2013
Owner	(APPLICANT) All In Beverages, LLC DBA There's No Plan B LIMITED LIABILITY COMPANY FLORIDA 13107 Luxbury Loop Orlando FLORIDA 32837
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE